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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,735	09/29/2003	Martin Miller	455610-2590.2	1934

20999 7590 12/27/2006  
FROMMER LAWRENCE & HAUG  
745 FIFTH AVENUE- 10TH FL.  
NEW YORK, NY 10151

EXAMINER
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CHUNG, PHUNG M

ART UNIT	PAPER NUMBER
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2138

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/27/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/673,735

Applicant(s)

MILLER ET AL.

Examiner

Phung My Chung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 22-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-10 and 17-21 is/are rejected.
- 7) ☒ Claim(s) 5-7 and 11-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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***Double Patenting***

1. Claims 1-4, 8-10 and 17-21 are remain provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-4 and 10-13 or copending application No. 10/673,712, and claims 1-4, 7 and 9 of copending application No. 10/673,713). (See paragraphs 3-4 of the previous office action).

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1 and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Tan et al (6,812,688).

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As per claims 1 and 17-20, Tan et al disclose an apparatus or a method, comprising:  
an acquisition unit (120) of a test instrument for acquiring a data signal for a  
predetermined time;

a memory of the test instrument for storing the data signal (acquisition memory,  
lines 64-65);

a clock recovery unit for recovering a clock signal from the stored data signal (col. 3,  
lines 26-30);

a processor (130) for slicing the stored data signal into a plurality of data segments of a  
predetermined length in accordance with the recovered clock signal ; and

a display (130) for overlaying the plurality of data segments in a time synchronized  
manner. (See Fig. 1, col. 2, lines 56-67 to col. 3, lines 1-2, col. 3, lines 12-25 and col. 1,  
lines 29-42).

4. Claims 5-7, 11-13 and 14-16 are objected to as being dependent upon a rejected base  
claim, but would be allowable if rewritten in independent form including all of the limitations of  
the base claim and any intervening claims.

5. Applicant argument filed on 10/10/06 have been fully considered but they are not  
persuasive because:

Applicant argues that the claims of the copending applications may change and it is  
premature to reject claims of the instant application on the ground of double patenting until  
prosecution of those applications has been completed.

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Examiner disagrees with applicant because the type of double patenting is the provisional rejection, obviousness type double patenting (MPEP, form paragraph 8.35) (not an anticipation rejection by a patent claims contain every element of the claims of the instant application). Therefore, it is not premature to reject claims of the instant application on the ground of double patenting before prosecution of those applications has been completed.

Applicant argues that, for example, claim 1 of the '713 application recites the storage and use of a software phase locked loop program, which is not recited in claim 1 of the instant application and claim 1 of '712 application recites synchronizing data segments to align them to a frame or predetermined pattern to determine a bit error rate and comparing each of the data segments to the predetermined pattern on a bit by bit basis, which is not found in claim 1 of the instant application.

Examiner disagrees with applicant because: even though, claim 1 of the '713 application recites the storage and use of a software phase locked loop program, which is not recited in claim 1 of the instant application and claim 1 of '712 application recites synchronizing data segments to align them to a frame or predetermined pattern to determine a bit error rate and comparing each of the data segments to the predetermined pattern on a bit by bit basis, which is not found in claim 1 of the instant application, but, for example, all of the limitations of claim 1 of the instant application are found in claim 1 of the copending application '712 and in claims 1-4, 7 and 9 of the copending application '713. The claims of the instant application are just broader in scope than the claims of the copending applications 10/673,712 and 10/673,713.

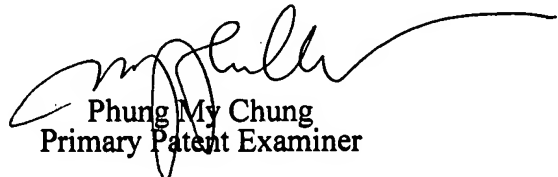
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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phung My Chung whose telephone number is 571-272-3818. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on 571-272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Phung My Chung  
Primary Patent Examiner